

Please rewrite Claim 33 to read as follows:

B1 33. (Amended) The system of claim 23, wherein the generator comprises a computer program that is installed on the user's computer at the same time as the application program from one of installation media and an installation file for the application program.

REMARKS

This patent application presently includes Claims 1-52 and 58-62, all of which stand rejected. Claim 33 is amended to correct an error in its dependency and all rejections are respectfully traversed.

Priority

The examiner has denied this application the benefit of the filing date of International Application No. PCT/US00/30987. Without citing authority, the examiner sets forth three requirements for claiming the benefit of an earlier application in this application. The examiner refers to 37 C.F.R. §1.53(d) which deals with continued prosecution applications. However, the present application is not a continued prosecution application, but a U.S. continuation of an International Application designating the United States. As will be demonstrated below, the standards cited by the examiner are incorrect.

The requirements for claiming the benefit of an earlier filed application are set forth 37 C.F.R. § 1.78(a)(1). As will be appreciated from subparagraph (i), the prior

filed application may be an International Application designating the United States of America. PCT/US00/30987 designated the United States of America.

The requirements for being able to claim the priority of an earlier International Application are that:

1. The international application must be copending;
2. It must name as an inventor at least one inventor named in the present application and
3. It must disclose the invention claimed in at least one claim of the present application.

International application PCT/US00/30987 expired on September 11, 2001. Accordingly, it was copending with the present application, satisfying requirement 1 above. The present application names the same inventor as the international application, satisfying requirement 2 above. Finally, every claim in the present application corresponds to at least one claim in the PCT application, satisfying requirement 3. The present application is therefore entitled to the filing date of the international application.

If the examiner disagrees with the conclusion of the preceding sentence, it is respectfully requested that he specifically set forth the authority for his position.

It is also noted that the applicant has met the requirement of 37 C.F.R. §1.7(a)(2), in that this application, as filed, contained a reference to it being a continuation of the international application.

Accordingly, the present application is a proper continuation of the international application and is entitled to the filing date of that application as its filing date, in the

same manner as any other continuation application. Thus, the effective filing date to accorded to the present application under 37 C.F.R. §1.78 is September 13, 2000.

International Application PCT/US00/30987 claimed the priority of U.S. Provisional Application No. 60/164,985 filed November 11, 1999. Under 35 U.S.C. §1.19(e), as quoted by the examiner, an international application (i.e. one filed under Section 363) filed by the same inventor as a provisional "shall have the same effect as to such invention as though filed on the date of the provisional application." Thus, the international application is entitled to the filing date of the provisional. Since the present application is a continuation of the International Application, it is also entitled to the same filing date.

Thus, for all purposes related to examination of the present patent application, the examiner must consider its effective filing date to be November 11, 1999.

The International Applications cited by the examiner are references as of their publication dates, and the filing date of the provisional application predates every one of them. Accordingly, none of them are proper references against the present patent application. For the same reason, the non-patent references cited by the examiner are not prior art.

In Paragraph 5 of the office action, starting at Page 4, the examiner requested responses to a Request for Information. The answers are provided below.

As for the first two subparagraphs , the responses is that there are no such publications.

As for the subparagraph bridging Pages 4 and 5, the examiner is advised that the improvements achieved by the claimed subject matter over the known prior art are explained at Page 1, Line 18 through Page 2, Line 2 of the application. The paragraph bridging Pages 1 and 2 and the immediately following paragraph describe fundamental differences of the present invention over the prior art.

Claim 23 includes "means for introducing." In the preferred embodiment, the character is introduced to the display through an HTML page. This is described in the paragraph starting at Page 5, Line 11. However, other means are also contemplated. For example, it may be provided in an Internet greeting card as described starting at Page 6, Line 25 or on software containing media, as described, starting at Page 7, Line 25. See also, Page 2, Lines 3-6.

In the first paragraph starting at Page 5 of the office action, the examiner notes that the applicant has not conducted a prior art search. This is correct. An international search was, however, conducted in the international application which is the parent of the present application. That search and an IPER were undertaken by the present examiner. In the IPER, he considered the same U.S. patents he now cited and interestingly, found all of the claims patentable for the reasons now presented by the applicant.

In the same paragraph on Page 5, the examiner comments that applicant has not asserted how advertising material found on Yahoo.com was originally compared to the claims in finding an infringement. That material was not available until long after the effective filing date of the present patent application. Accordingly, it cannot possibly have

any relevance to the examination of the present patent application, and it is not understood while the examiner even mentions it.

In response to the specific request made in the middle of Page 5 of the office action, the examiner is advised that the present patent application was drafted based upon written and verbal disclosures provided by the applicant. On information and belief, no information of the type suggested by the examiner was used in the invention process. That is, there was no designing around or providing a solution to published features.

Next, the examiner requires identification of what is being improved. This is merely redundant of what was requested previously and has already been responded to.

Every effort has been made to respond to the requirements for information as candidly and completely as possible, to the extent that they are applicable and responsive information is available.

Claim 33 was rejected under 35 U.S.C. §101 as claiming a system depending from a method claim. This resulted from a typographical error in the dependency of Claim 33. With the present amendment, Claim 33 has been corrected so as to be dependent from Claim 23, and this rejection should therefore be withdrawn.

All claims were rejected under 35 U.S.C. §112 as containing subject matter which was not described so as to provide an enabling disclosure. Specifically, the examiner asserts that the following features are not adequately disclosed in the application:

1. Introducing a multimedia character into a computer screen;

2. Communicating a tag to a character controlling server based on client/server communications; and
3. Selecting a character, greeting, recipient and message.

As explained in the application, the claimed invention can be realized with existing technology (this is stated specifically at the top of Page 2). Thus, the applicant is not asserting the invention to be any specific technique for delivering the character or realizing the character, but only the specific methods and systems claimed. In the preferred embodiment, a multi-media character is introduced to a user's computer through an HTML file viewed on his browser. Anyone who has ever accessed the worldwide web has had the experience of having multi-media information transferred to his computer through an HTML file. This is a common technical expedient, well-known to those skilled in the art, and requires no detailed explanation.

The application does describe starting Page 4, Line 24 that the preferred animation software is "Flash" by Micromedia. This paragraph explains how the Flash program is utilized to design the multimedia character. The character is introduced on the top layer of the browser window using a public domain JavaScript in the HTML file. Those skilled in the art would be quite familiar with the use of the Flash program and a JavaScript to achieve the results described. Moreover, the use of such executable scripts with HTML pages is a common way to achieve processing on a page.

In the first paragraph starting at Page 5 of the application, the use of alternate technology is described. In this case, the character is an animated GIF file and the audio is a WAV object drawn into the HTML code by a JavaScript which executes

when the HTML page is presented on the user's computer. Again, this technology is well known to those skilled in the art, and further explanation is not necessary to enable them to practice this embodiment of the invention as described.

Thus, there is a more than adequate disclosure for introducing or displaying a multimedia animated character into a computer screen.

As for the concept of communicating a tag to a character controlling server based on client/server communications, this is a concept which is quite familiar to all users of the worldwide web. Basically, an HTML page has a tag, or address, which causes access to a remote location for a further file or HTML page. In its most common form, the tag could be an icon on a page which, when clicked, causes a new page to be received. Of course, a tag could be processed automatically if an HTML page contains an executable script for activating the tag. Those skilled in the art would be quite familiar with the concept of using a tag in a HTML page to cause a transfer to another page or the receipt of a file, and no further description would be necessary.

As for the features of selecting a character, greeting, recipient or message, it is common on the worldwide web to have selectable content received. Page 4, Lines 7-23 describes a method for keeping track of characters which have been provided to a particular user. Furthermore, Page 2, Lines 7-18 describe the use of a database for a client, so those skilled in the art would understand that a complete advertising campaign can be stored for a user. The same paragraph also explains the overall operation of how the characters are generated and provided to the user. Such operations are commonly

performed on the worldwide web, and those skilled in the art would be very familiar with how to accomplish them.

With respect to Claims 7, 10, 19, 20, 29, 32, 38, 41, 46, 51 and 62, the examiner stated that the specification does not teach one skilled in the art to define a plurality of characters which are selected and controlled according to information from the user's computer which is not under the user's control. It is believed that from the technical features discussed above, as described in the application, those skilled in the art would readily know how to achieve these results. It is by now commonplace on the worldwide web to select files to be provided to a user based upon information present on the user's computer, for example, in the form of cookies.

The examiner also stated that describing the lack of user control is not enabling, because the user always has control of a computer. As the examiner should appreciate, this is clearly not the case. A user, for example, does not have control over the appearance of banner ads when he receives a page.

The examiner also stated that the description of a tag is not enabling because one skilled in the art would not be able to use tags as claimed based upon the specification. Nothing could be further from the truth. As explained above, tags are used, thousands if not millions of times a day on the worldwide web to achieve transfer from one internet page to another or to cause information to be transfer to a user's computer after he views a particular page. This was discussed above. Various ways of executing a tag are also quite well known to those skilled in the art, for example, user clicks on an icon or the operation of an executable such as a JavaScript.

For all of the above reasons, the present application is clearly enabling to those skilled in the art and the rejection under 35 U.S.C. §112 on that basis should be withdrawn.

Claims 1-52 and 58-62 were also rejected under 35 U.S.C. §112 as indefinite. The examiner offered no particular respects in which the language of the claims was considered to be indefinite. Instead, he merely repeated the substance of the prior rejection under 35 U.S.C. §112. As pointed out above, the subject matter noted by the examiner was entirely enabled to those skilled in the art by the disclosure of the present patent application. Accordingly, these claims are believed to be clear and concise for the reasons as stated above, and this rejection under 35 U.S.C. §112 should be therefore be withdrawn.

Claims 1-52 and 58-62 were rejected under 35 U.S.C. §102(a) as anticipated by a number of international publications and US patents as well as one non-patent literature reference. As pointed out above, the dates of the international publications and the non-patent reference are too late to make them appropriate prior art references under 35 U.S.C. §102. The U.S. patents cited by the examiner are discussed specifically below.

Petrecca, Riley, and Schena all relate to advertising systems on computers or networks. However, none of these patents teach or even remotely suggest modifying an image produced on a computer by introducing a multimedia animated character, which is a changing image that appears on the screen intrusively in a manner which is unpredictable for the user and which is completely beyond his control.

Cohen relates to a standalone promotional game method and apparatus, similar to a slot machine, and has absolutely nothing to do with a user's computer, much less the introduction of a type of character mentioned above.

The Wexler patent relates to a system using banner advertising, which is discussed in the present application. The present invention seeks to avoid the use of such banner advertising. Moreover, there is not the slightest suggestion in Wexler of using the type of character described above or that it would be of any benefit. The only significance of this patent is that it demonstrates that the use of tags is well-known. In this case, the tag is included in a banner provided on a web page with which the user is viewing.

Like Wexler, Alberts relates to a banner advertising system, which the present invention seeks to avoid. Also like Wexler, Alberts does not teach or even suggest the type of character discussed above or that it would be of any benefit. The only significant of Alberts to the present invention is that it discloses the use of a database for advertising campaign information.

In view of the foregoing, it is clear that none of the U.S. discussed above teaches or suggests the claimed invention or that it would be of any benefit. Accordingly, all of the claims are believed to be allowable over those patents.

All of the claims in the application are rejected as obvious over Juno online services as represented from the examiner's personal knowledge. The applicant therefore calls upon the examiner to support such rejection with his affidavit, as required by 35 C.F.R. 1.104(d)(2), which shall be subject to contradiction or explanation by the affidavits of

appropriate experts. In addition, that rule requires that the examiner's data be as specific as possible.

As best as can be determined from the general explanation of how Juno is applicable. It is believed that the examiner is referring to so-called "pop-up" advertising. Pop-up advertising is nothing but another form of box or banner. Also, the examiner admits that Juno does not include the "intrusive, unpredictable, and uncontrollable nature of the character." For these teachings, the examiner simply makes the bald assertion that those differences are obvious, without any prior art support.

At the same time, pop-up advertising shares many of the shortcomings of banner advertising, including lacking in interest (overcome by the use of a multimedia *character*) and covering up the content of the page being viewed (overcome by the movement of the character). Those are among the differences that make the invention of the present patent application advantageous over Juno and other prior art as a result of achieving the benefits described in the patent application at Pages 1-2. Moreover, those benefits could not be achieved by the Juno system, so it could hardly be concluded that the claimed invention is obvious thereover.

The examiner also stated that the intrusive, unpredictable, and uncontrollable feature is merely non-functional descriptive language which is not functionally involved in the steps recited. However, nothing could be further from the truth. Those steps define the manner in which the character is introduced to the screen, and introducing of the character is a primary functional step in the method. It is as inappropriate to ignore the manner in which a step is performed as it would be to ignore the size or shape of a physical element.

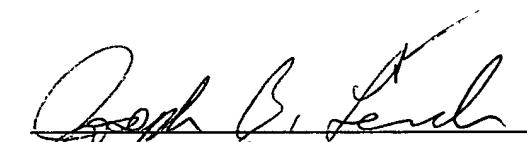
It is therefore clear that the examiner has not given full and fair consideration to all of the limitations of the claims and that the obviousness rejection is therefore erroneous and improper.

For all of the above reasons, the obviousness rejection based upon Juno should be withdrawn, and all of the claims should be allowed.

After the examiner has given full consideration to the present amendment, but before he acts on it, it is respectfully requested that he call the undersigned, and that arrangements may be made for an interview.

Applicant's attorney has made every effort to place this patent application in condition for allowance. It is therefore earnestly requested that this application, as a whole, receive favorable reconsideration and that all of the claims be allowed as presently constituted.

Respectfully submitted,


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PATENT TRADEMARK OFFICE

Docket No.: 2875/1G342US1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Samuel Sergio TENENBAUM

Serial No: 09/922,232

Group Art Unit: 3622

Filed: August 3, 2001

Examiner: Michael S. Gravini

Confirmation No.: 7566

For: COMPUTERIZED ADVERTISING METHOD AND SYSTEM

AMENDMENT MARK-UP SHEET FOR AMENDMENT RESPONSIVE TO
OFFICE ACTION OF

Commissioner of Patents and Trademarks
Washington DC 20231

In the Claims:

Please rewrite Claim 33 to read as follows:

33. (Amended) The system of claim [1] 23, wherein the generator comprises a computer program that is installed on the user's computer at the same time as the application program from one of installation media and an installation file for the application program.